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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,923	06/19/2000	NORMAN BRYSON ROBERTS	PM266300	3694

909 7590 10/16/2002

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EXAMINER

VANOY, TIMOTHY C

ART UNIT	PAPER NUMBER
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1754

13

DATE MAILED: 10/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09-508,923

Applicant(s)

ROBERTS et al.

Examiner

VANDY

Group Art Unit

1754

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on SEPT. 24, 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 15-20 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 18 AND 20 is/are allowed.
- ☒ Claim(s) 15, 16, 17 AND 19 is/are rejected.
- ☒ Claim(s) 15, 16 AND 19 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 12 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

DETAILED ACTION

Response to Amendment

The 116 Amendment dated Sept. 24, 2002 (paper no. 11) has been entered, however this new, non-final Office Action is being submitted in response to this 116 Amendment because the Examiner has found new prior art that anticipates some of the Applicants' claims, wherein this new prior art has not been previously made of record.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it does not identify the city and state or foreign country of the inventor "Mr. Norman Bryson Roberts" or the inventor "Mr. Maurice Webb".

The Applicants' comment on pg. 4 in their Amendment dated Sept. 24, 2002 that a new declaration will be obtained and filed as soon as possible is noted.

Claim Objections

a) Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is

Art Unit: 1754

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The Applicants argue that claim 16 is more specific and further limits claim 15 because fewer compounds are expected to meet this more stringent criteria (of being able to bind phosphorus at a pH ranging from 2 to 8?).

This objection is maintained because claim 15 recites a pH range of 3 to 7, whereas claim 16 sets forth a *broader* pH range of from 2 to 8, and claim 16 is not limited to any specific compound that would meet this argued more stringent criteria.

b) In claim 15 test (1) and claim 19 step (1), "of 30 minutes" should be replaced with "for 30 minutes".

c) Claim 19 is objected to for being a functional duplicate of claim 16 in as much as claim 19 is specific to one of Markush species recited in claim 16. Alternatively, in claim 16 when magnesium is selected from the Markush group as the "additional metal", then claims 16 and 19 are duplicates.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 16, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by the article titled "Preparation, Characterization, and Mossbauer

Art Unit: 1754

Spectroscopy. . ." by Raki et al. published in Chem. Mater. Vol. 7 No. 1 (1995) pgs. 221-224.

The "Introduction" section of the Raki et al. article sets forth that pyroaurite, $\text{Mg}_6\text{Fe}_2(\text{OH})_{16}\text{CO}_3 \cdot 4\text{H}_2\text{O}$, is a naturally occurring anionic clay material. Pyroaurite is not seen to be distinct from the composition of Applicants' claims 15, 16, 17 and 19. The limitations describing the phosphate binding capacity of the composition as measured by the recited tests and at over the recited pH range are noted, but such recognition of latent properties inherently present in the prior art composition does not distinguish the composition *per se*: please see the discussion of the *In re Wiseman* 596 F.2d 1019, 201 USPQ 658 (CCPA 1979) court decision set forth in section 2145(II) in the MPEP (8th ed.).

Claim 18 has not been rejected under either 35USC102 or 35USC103 because there is nothing the description of the pyroaurite set forth in the "Introduction" section of the Raki et al. article that teaches or suggests that pyroaurite may also contain the claimed sulfate, chloride, oxide or mixtures thereof. Claim 20 has not been rejected under 35USC102 or 35USC103 because there is nothing in the Raki et al. article or the article titled "Hydrotalcites as Potential Adsorbents of Intestinal Phosphate" teaching or suggesting that pyroaurite can be used to treat hyperphosphataemia.

Response to Arguments

Art Unit: 1754

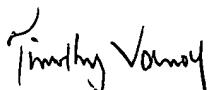
The Applicants' arguments submitted in their 116 Amendment regarding the 102 and 103 rejections have been fully considered but they are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy C. Vanoy whose telephone number is 703-308-2540. The examiner can normally be reached on 8 hr. days.

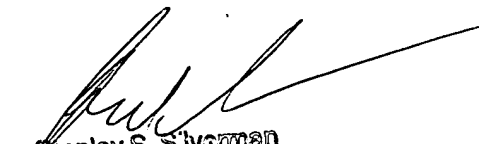
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached at phone no. 703-308-3837. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Timothy Vanoy/tv
October 7, 2002


Timothy Vandy
Patent Examiner

Art Unit 1754


Stanley S. Silverman
Supervisory Patent Examiner
Technology Center 1700